REMARKS

Applicant is in receipt of the Office Action mailed August 8, 2005. Claims 1, 16, and 32 have been amended. New claim 47 has been added. Thus, claims 1-47 are pending in the case. Reconsideration of the present case is earnestly requested in light of the following remarks.

Double Patenting Rejection

Claims 1-9, 15-24, 31-40, and 46 have been rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 7, 11, 49, 21, 44, and 62 of U.S. Patent No. 6,687,245 B2. Applicant has accordingly provided a copy of the terminal disclaimer (previously submitted on April 7, 2005) for the patent application herewith. Applicant respectfully requests removal of the double patenting rejection.

Section 102 Rejections

Claims 1, 32, 17, 33, 3, 18, 34, 4, 19, 35, 5, 7, 20, 22, 36, 38, 15, 46, 31, 6, 21, 37, and 16 were rejected under 35 U.S.C. 102(e) as being anticipated by Schuster et al. (U.S. Patent No. 6,822,957 B1, "Schuster"). Applicant respectfully traverses the rejection. .

As the Examiner is certainly aware, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Amended claim 1 recites:

1. (Currently Amended) A method for performing IP telephony, comprising:

a Service Gateway receiving a data packet from an IP telephone, wherein the data packet comprises a private source IP address of the IP telephone, a source port number, and destination information associated with an IP device;

the Service Gateway performing a network address persistent port translation (NAPPT) on the data packet, including storing translation information in a data structure, wherein the translation information comprises:

the private source IP address of the IP telephone;

a public IP address of the Service Gateway; and

assigned ports for the IP telephone; and

the Service Gateway sending the data packet to the IP device.

Applicant respectfully submits that Schuster fails to teach all the features and limitations of amended claim 1.

As described in the text cited by the Office Action, Schuster discloses a first network phone on a first network requesting at least one locally unique port from a first network device on the network, the first network phone receiving the at least one locally unique port from the first network device, and creating a combination network address for the first network phone with the at least one locally unique port and a common external network address to identify the first network telephone for communications with a second network device on a second network, e.g., a second network phone (col. 3:20-32); A first network phone transmitting an INVITE request to a proxy server on a second network, where the INVITE request includes the caller's SIP (Session Initiation Protocol) address, the callee's (second network phone) SIP address (col. 8:45-50); The network phone having a pre-programmed device identifier (e.g., phone number), represented as a SIP-URI of the form sip: user @ domain, where after power-up, the phone sends a SIP REGISTER message to a default registrar, e.g., a proxy server, and where the proxy server forwards calls for a registered SIP URI to the appropriate destination (col. 10; 23-32); A network device using a locally unique port to replace a default or local port in a protocol layer in a layered protocol stack, and a network phone assigning one of a range of locally unique ports assigned to the phone to TCP to use as a source port for the phone (col. 16:13-20); and Distributed Network Address Translation, where the network phone requests one or more locally unique ports from a second network device (e.g., router or a proxy server), which are used to replace default ports in protocol layers in a layered protocol stack on the first network device (the network phone), and which are further

14

used to create a combination network address including a locally unique port and a common external address to communicate with a second external computer network without address translation (Figure 9; col. 15:32-47).

Nowhere do the cited passages of Schuster (or Schuster in general) disclose "a Service Gateway receiving a data packet from an IP telephone, wherein the data packet comprises a private source IP address of the IP telephone, a source port number, and destination information associated with an IP device; and the Service Gateway performing a network address persistent port translation (NAPPT) on the data packet, *including storing translation information in a data structure, wherein the translation information comprises: the private source IP address of the IP telephone; a public IP address of the Service Gateway; and assigned ports for the IP telephone*", as recited in claim 1. In fact, the only data storage disclosed by Schuster for port translation information are: a data structure for locally unique ports for use by a network device, which lists the locally unique ports available for the device (Table 1), and a port-to-internal-network address table that stores an internal network address, lowest port, and number of ports, for each of one or more network devices. Thus, Schuster fails to disclose a Service Gateway *storing translation information in a data structure* including *the private source IP address of the IP telephone; a public IP address of the Service Gateway; and assigned ports for the IP telephone.*

Claims 16 and 32 (and new claim 47) include similar limitations as claim 1, and so the above arguments apply with equal force to these claims. Thus, for at least the reasons provided above, Applicant respectfully submits that claims 1, 16, and 32 (as well as new claim 47), and those claims respectively dependent therefrom, are patentably distinct and non-obvious over Schuster, and are thus allowable.

Removal of the section 102 rejection of claims 1, 32, 17, 33, 3, 18, 34, 4, 19, 35, 5, 7, 20, 22, 36, 38, 15, 46, 31, 6, 21, 37, and 16 is respectfully requested.

Section 103 Rejections

Claims 8, 23, 39, 30, 9, 24, 40, 10, 25, 41, 11, 12, 26, 27, 42, 43, 13, 28, 44, 14, 29, and 45 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster in

15

view of Fijolek et al. (U.S. Patent No. 6,577,642 B1, "Fijolek"). Applicant respectfully traverses the rejection.

Applicant submits that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since the independent claims have been shown to be patentably distinct and non-obvious, their respective dependent claims are similarly patentably distinct and non-obvious, and are thus allowable.

Additionally, Applicant submits that various of the dependent claims include limitations not taught or suggested by Schuster and/or Fijolek. For example, the Office Action admits that Schuster fails to teach all the features and limitations of claims 8, 23, 30, and 39, specifically, "wherein the identifier comprises a vendor class identifier", but then asserts that Fijolek remedies this admitted deficiency of Schuster, citing col. 10:60-67, col. 11:5-9, col. 11-col. 12, and Table 1. Applicant respectfully disagrees.

Applicant submits that Fijolek does not disclose a *vendor class identifier*, but rather discloses a vendor ID included in a configuration file that is sent to a cable model or a CPE (Customer Premise Equipment), e.g., a personal computer, which is not the same thing, nor used for the same purpose. Applicant notes, for example, that the vendor class identifier recited in claims 8, 23, 30, and 39 is a standard DHCP option (specifically, option #60). Fijolek nowhere describes the vendor ID as a *vendor class ID*. Additionally, Applicant notes that Fijolek's vendor ID is included in a configuration file that is sent to the cable modem (or CPE) *after* the IP address has been assigned to the device. In direct contrast, in the present invention as represented in claims 8, 23, 30, and 39, the vendor class identifier is provided *prior to* port range or IP address assignment.

Thus, Applicant respectfully submits that Schuster and Fijolek fail to teach or suggest this limitation of claims 8, 23, 30, and 39, and so these claims, and those claims respectively dependent therefrom, are patentably distinct and non-obvious over Schuster and Fijolek, and are thus allowable.

Applicant notes that to establish a prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. In re Bond, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

Moreover, as held by the U.S. Court of Appeals for the Federal Circuit in Ecolochem Inc. v. Southern California Edison Co., an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis.

In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular . . .. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Regarding the Examiner's attempted combination of Schuster and Fijolek, Applicant respectfully submits that a proper motivation to combine has not been provided. For example, the only motivation to combine suggested by the Examiner is "in order to provide a variety of service offerings via and through a data-over-cable system". Applicant submits that such a general statement (actually, a quotation from Fijolek) in no way constitutes a proper motivation to combine the references. Note that per *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), the art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Nowhere does Schuster indicate the desirability of using a *vendor class identifier*, as recited in claims 8, 23, and 39. Nor does Fijolek disclose such an identifier, nor indicate the desirability of using a vendor class identifier as an identifier for an IP telephone. Thus, Applicant submits that the attempted combination of Schuster and

17

Fijolek is improper. Moreover, Applicant submits that even were Schuster and Fijolek properly combinable, which Applicant argues they are not, the resulting combination would still not produce Applicant's invention as claimed, as argued at length above.

Thus, Applicant submits that Schuster and Fijolek, taken singly or in combination, fail to teach all the features and limitations of claims 8, 23, 39, 30, 9, 24, 40, 10, 25, 41, 11, 12, 26, 27, 42, 43, 13, 28, 44, 14, 29, and 45. Thus, for at least these reasons, Applicant respectfully submits that claims 8, 23, 39, 30, 9, 24, 40, 10, 25, 41, 11, 12, 26, 27, 42, 43, 13, 28, 44, 14, 29, and 45, and those claims respectively dependent therefrom, are patentably distinct and non-obvious over Schuster and Fijolek, and are thus allowable.

Removal of the section 103 rejection of claims 8, 23, 39, 30, 9, 24, 40, 10, 25, 41, 11, 12, 26, 27, 42, 43, 13, 28, 44, 14, 29, and 45 is earnestly requested.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5686-00400/JCH.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

☒ Copy of Terminal Disclaimer submitted on April 7, 2005

☒ Copy of Power of Attorney By Assignee and Revocation of Previous Powers submitted on April 7, 2005

Respectfully submitted,

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